

## IN THE UNITED STATES RECEIVING OFFICE

Applicant : THOMAS GORDAN ; BARRY MORGAN  
Serial No. : 09/868,356  
Filed : June 15, 2001  
Title : PRENYL TRANSFERASE INHIBITORS

**BOX PCT**

Commissioner for Patents  
Washington, D.C. 20231

RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS

Responsive to the Notification of Missing Requirements under 35 U.S.C. 371  
mailed August 2, 2001, Applicant as a large entity submits herewith the following:

- ☐ Payment of the basic filing fee of \$0;
- ☐ Payment of the additional/multiple dependent claims fees of \$0;
- ☒ Payment of the surcharge of \$130 for late filing of the basic filing fee and/or declaration.
- ☒ A check in the total amount of \$130 is attached.
- ☐ A Verified Statement Claiming Small Entity Status;
- ☒ A Combined Declaration and Power of Attorney in compliance with 37 CFR §1.63;
- ☐ A verified English translation of the application and payment of the \$0 fee required under 37 CFR §1.17(k); and
- ☐ Other:

08/15/2001 MKAYPAGH 00000023 09868356

01 FC:154

130.00 0P

## CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mail Label No. EL 485514486 US

I hereby certify under 37 CFR §1.10 that this correspondence is being deposited with the United States Postal Service as Express Mail Post Office to Addressee with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit

August 10, 2001

Signature

Samantha Bell  
Samantha Bell

Typed or Printed Name of Person Signing Certificate



## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

U.S. APPLICATION NO. 09/868356 FIRST NAMED APPLICANT GORDON ATTORNEY/AGENT NO. 00537-188002

Y. ROCKY TSAO  
FISH & RICHARDSON  
225 FRANKLIN STREET  
BOSTON, MA 02110 2804

RECEIVED

AUG 06 2001

FISH & RICHARDSON, P.C.  
BOSTON OFFICE

INTERNATIONAL APPLICATION NO.

PCT/US99/31302

I.A. FILING DATE PRIORITY DATE

30 DEC 99

31 DEC 98

DATE MAILED: 02 AUG 2001

## NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☒ an Elected Office (37 CFR 1.495):

- |  |  |
|--|--|
| <input checked="" type="checkbox"/> U.S. Basic National Fee.   | <input type="checkbox"/> Indication of Small Entity Status.                                    |
| <input checked="" type="checkbox"/> Copy of the international application.   | <input checked="" type="checkbox"/> Translation of the international application into English. |
| <input type="checkbox"/> Oath or Declaration of inventors(s).  | <input type="checkbox"/> Translation of Article 19 amendments into English.                    |
| <input type="checkbox"/> Copy of Article 19 amendments.  | <input type="checkbox"/> Other:  |
| <input checked="" type="checkbox"/> Priority Document.   |  |
| <input checked="" type="checkbox"/> The International Preliminary Examination Report in English and its Annexes, if any. |  |
| <input type="checkbox"/> Translation of Annexes to the International Preliminary Examination Report into English.        |  |

2. ☐ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.

- |   |   |
|---|---|
| <input type="checkbox"/> U.S. Basic National Fee. | <input type="checkbox"/> Copy of the international application. |
|---|---|

3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- |   |  |
|---|--|
| <input type="checkbox"/> a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.  |  |
| <input type="checkbox"/> The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.  |  |
| <input type="checkbox"/> b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).   |  |
| <input checked="" type="checkbox"/> c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b) properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date. |  |
| <input type="checkbox"/> The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.  |  |
| <input checked="" type="checkbox"/> d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).   |  |

4. Additional claim fees of \$ \_\_\_\_\_ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.5. ☐ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.**ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes **MUST** be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.7. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

**A copy of this notice MUST be returned with this response.**

- |  |  |
|--|--|
| Enclosed: <input type="checkbox"/> PCT/DO/EO/917 | <input type="checkbox"/> Notice of Defective Translation |
| <input type="checkbox"/> PTO-875                 | <input type="checkbox"/> PCT/DO/EO/920                   |

Deborah D. Williams

FORM PCT/DO/EO/905 (March 2001)

Telephone: 703-305-3744

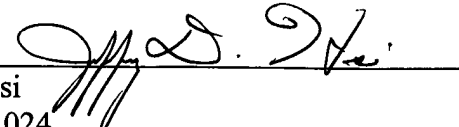
Applicant : THOMAS GORDAN ; BARRY  
MORGAN  
Serial No. : 09/868,356  
Filed : June 15, 2001  
Page : 2

Attorney's Docket No.: 00537-  
188002 / 084/US/PCT2/US

It is understood that this perfects the application and no additional papers or filing fees are required. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: August 9, 2001

  
\_\_\_\_\_  
Jeffrey D. Hsi  
Reg. No. 40,024

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110-2804  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906

EL 485514486US

PATENT  
Attorney's Docket No.: 00537-188002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: THOMAS GORDAN ; BARRY MORGAN  
Serial No.: 09/868,356  
Filed: June 15, 2001  
Title: PRENYL TRANSFERASE INHIBITORS

Commissioner for Patents  
Washington, DC 20231

DECLARATION OF MAILING BY "EXPRESS MAIL"

declares as follows:

1. I reside at:

and am an employee of:

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110-2804

2. On August , 2001, I deposited in the mail, "Express Mail Post Office to Addressee" service of the United States Postal Service, the contents of the envelope for which "Express Mail" receipt No. EL 485514486 US was issued addressed to the Commissioner for Patents, Washington, DC 20231.

3. Attached hereto is a true copy of the "Express Mail" receipt No. EL 485514486 US.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified application or any patents issued thereon.

Date: August , 2001

---